

REMARKS

Claims 1-10 and 36-45 are pending in this application. Claims 1-66 stand rejected. By this Amendment, claims 11-35 and 46-66 are cancelled without prejudice. In light of the amendments and remarks set forth below, Applicants respectfully submits that each of the pending claims is in immediate condition for allowance.

Pending claims 1-10 and 36-45 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,930,778 (“Geer”) in view of U.S. Patent No. 5,678,046 (“Cahill”). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Among the limitations of independent claim 1 not present in the cited reference is “receiving the paper-based banking transactions after having received the ECP file.” Likewise, claim 36 explicitly recites “receiving the paper-based banking

transactions after the first processor received the ECP file.” The above limitations are not disclosed in Geer or Cahill.

Geer includes two different examples. In neither example is a paper based banking transaction received after an ECP file. In a first example, physical checks never leave the payee. Each payee only sends electronic information to their depositor bank. In the second example, there is not an Electronic Cash Letter or Electronic Cash Presentment as recited in the claims. Therefore, there can never be a situation when paper based transactions are received after an ECP.

The Office Action asserts that Geer assigns a unique first item sequence to each respective first item as recited in the claim. However, in the cited portion of Geer there has not yet been an ECP received, or an ECP generated, which, in fact, Geer never does. Further, there is no description of the receipt of an ECP.

Additionally, Among the limitations of independent claim 1 not present in the cited reference is “correlating the first and second records.” Likewise, claim 36 explicitly recites a third processor correlating the first and second records. The above limitations are not disclosed in Geer.

The Office Action asserts that Geer discloses correlating the first and second records at column 13, lines 44-49. Applicants respectfully disagree with this interpretation of Geer.

At the cited portion, Geer states that an archive may be maintained by the payee on behalf of the depository bank for received checks. Each check received by

the payee is scanned for financial information, imaged and assigned a unique document identification number for retrieval purposes. In other words, each paper check received would be scanned for the relevant financial data contained therein (to create a first record), and each check would then be imaged, and the image would receive a unique identifier so that the image can be retrieved at a later date (second record). Thus, the first and second records in Geer are different than the claimed first and second records. In Geer, there is only “correlation” between a check image and a document identification number, i.e., an image and its file name. As such, Geer fails to disclose correlating the first and second records as explicitly recited in Applicants’ claim.

Cahill is not included to cure the above-recited deficiency in Geer but to show additional limitations which the Office Action admits are not present in Geer. Cahill is added to disclose “discarding the second item sequence numbers.” However, in Cahill a TIFF image is deleted from storage space once a “BLOB” file is created. Thus, Cahill fails to teach discarding a sequence number as asserted in the Office Action.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection to claims 1-10 and 36-45 and the allowance of those claims.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

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